

### C) REMARKS

This Response is filed in response to the Office Action dated May 17, 2006.

Upon entry of this Response, claims 44-82 will be pending in the Application.

In the outstanding Office Action, the Examiner rejected claims 44-80 under 35 U.S.C. 103(a) as being unpatentable over Anandan et al. (U.S. Patent Application Publication No. 2002/0062251) in view of Herrod et al. (U.S. Patent No. 6,405,049).

#### **Rejection under 35 U.S.C. 103**

The Examiner rejected claims 44-80 under 35 U.S.C. 103(a) as being unpatentable over Anandan et al. (U.S. Patent Application Publication No. 2002/0062251), hereinafter referred to as "Anandan" in view of Herrod et al. (U.S. Patent No. 6,405,049), hereafter referred to as "Herrod." It is noted that in the outstanding Office Action the Examiner has identified Anandan as having a publication number of 2003/0021242, which identification information is believed to be in error based on the information in the Notice of References Cited supplied by the Examiner in a previous Office Action.

Specifically, the Examiner stated that

5. As per claim 44 and 68, Anandan et al teach a system (fig 1) for providing personalized information (*targeted electronic communication*) to a user (*Panel member, 700*) in a commercial establishment, the system comprising at least one database storing information related to a user, a portable display unit operated by a user in a commercial establishment; the portable display unit having a unique identifier, and the portable display unit comprising a transceiver at least one database, a user interface, a display screen, a microprocessor, and at least one program executable by the microprocessor to enable the portable display unit to receive, store, and display information to a user in a commercial establishment; a location tracking system to determine a location of the portable display unit in a commercial establishment, a server computer the server computer being in communication with the location tracking system and the at least one database and the server computer being configured to generate personalized information for a user in a commercial establishment based on the location of the portable display unit and the information related to a user stored in the at least one database, and at least one transceiver in communication with the server computer for transmitting the personalized information generated by the server

computer to the portable display unit (see abstract, paragraphs 0003, 0007, 0009, 00011, 0012, 0013, 0026, 0027, 0028, 0035, 0037, 0041, 0043, 0044, 0042, 0065, 0069); Anandan et al fail to teach an inventive concept of providing a plurality or portable display units for use by a plurality of users in a commercial establishment and activating by a user a portable unit to operate in a commercial establishment by providing identifying information. However, Herrod et al teaches plurality of users in a commercial establishment and activating by a user a portable unit to operate in a commercial establishment by providing identifying information (see column 10 lines 25-17 lines 39). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify inventive concept of Anandan et al to include Herrod et al's plurality of users in a commercial establishment and activating by a user a portable unit to operate in a commercial establishment by providing identifying information because this would have ensured on the spot communication between the user and the commercial establishment.

Applicants respectfully traverse the rejection of claims 44-80 under 35 U.S.C. § 103(a).

Anandan, as understood, is directed to a system and method for conducting consumer research and marketing using wireless technologies. The system for communicating with a consumer includes a wireless identification device associated with the consumer at a premises, a wireless identification device detector to communicate with the wireless identification device, a first computer in communication with the wireless identification device detector for identifying the consumer associated with the wireless identification device, a wireless reception device associated with the consumer, and a second computer in communication with the first computer, for transmitting a message to the wireless reception device, the content of the message being responsive to the premises' identity or responsive to the premises' contents. The message to the consumer includes prompts to elicit information from the consumer relating to the premises, a customer satisfaction survey, a product promotion, a link to an Internet page, alphanumeric text, or a voice message.

Herrod, as understood, is directed to a portable data device and a cradle for receiving the portable data device. The cradle is arranged to recharge the portable data device power supply and/or upload or download information to and from the portable data device. The cradle and portable data device are in wireless communication allowing a minimum of processing and data storage capability at the front end and hence operation of the portable data device as a thin client.

One application of the portable data device is a retail application where the retail outlet provides a plurality of portable terminals in their respective cradles. The customer selects a terminal from a cradle. Also provided in the retail outlet is a plurality of wireless transmitters or access points, at appropriate locations. As the customer moves about the retail outlet the access points broadcast to the terminal. The access point transmits information concerning products available in the locality of the terminal.

In contrast, independent claim 44 recites a system for providing personalized information to a user in a commercial establishment, the system comprising: at least one database storing information related to a user; a plurality of portable display units located in a commercial establishment for use by a plurality of users in a commercial establishment, each portable display unit of the plurality of portable display units having a unique identifier, and each portable display unit comprising a transceiver, a memory device, a user interface, a display screen, a microprocessor, and at least one program executable by the microprocessor to enable receiving, storing and displaying of information to a user in a commercial establishment, wherein a user activates a portable display unit of the plurality of portable display units to operate in a commercial establishment by providing identifying information; a location tracking system to determine a location of the activated portable display unit in a commercial establishment; a server computer, the server computer being in communication with the location tracking system and the at least one database and the server computer being configured to generate personalized information for a user in a commercial establishment based on the location of the activated portable display unit and the information related to a user stored in the at least one database; and at least one transceiver in communication with the server computer for transmitting the personalized information generated by the server computer to the activated portable display unit.

Independent claim 68 recites a method of providing personalized information to a user in a commercial establishment, comprising the steps of: providing a plurality of portable display units for use by a plurality of users in a commercial establishment; storing information related to a user in at least one database; activating, by a user, a portable display unit of the plurality of portable display units to operate in a commercial establishment by providing identifying information; determining a location of a user in a commercial establishment with a location tracking system; generating personalized information for a user in a commercial establishment

based on the location of a user in a commercial establishment and the information related to a user stored in the at least one database; and transmitting the generated personalized information to the portable display unit operated by a user in a commercial establishment, the portable display unit having a transceiver, a memory device, a user interface, a display screen, a microprocessor, and at least one program executable by the microprocessor to enable the portable display unit to receive, store, and display the personalized information to a user in a commercial establishment.

Applicant respectfully submits that the Examiner has improperly combined Anandan and Herrod. The Examiner has provided no teaching or suggestion in Anandan that would indicate the desirability of incorporating into Anandan the plurality of terminals from Herrod, nor has the Examiner cited any passage in Herrod that would indicate that the activation of a terminal of the plurality of terminals by a user from Herrod can be used in the device of Anandan. The Examiner makes a statement that one would be motivated to make the modification to ensure “on the spot communication between the user and the commercial establishment.” However, the Examiner provides no support for this conclusion in either Anandan or Herrod. Furthermore, Applicant submits that the Examiner has already asserted that Anandan discusses this feature (*See Office Action, page 3, lines 8-10*), thus there would be no need to make the proposed combination as Anandan already has the feature to be added by the proposed combination with Herrod. Thus, Applicant respectfully submits that the Examiner has improperly combined Anandan and Herrod based on the teachings in Applicant’s specification, which is impermissible hindsight reasoning by the Examiner. Applicant would like to point out to the Examiner that:

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention “as a whole.” Inventions typically are new combinations of existing principles or features. *Env'l. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 [218 USPQ 865] (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements.”). The “as a whole” instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an “as a whole” assessment of the invention under §103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355-56 [47 USPQ2d 1453] (Fed. Cir. 1998).

*Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004)

Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination.” See Manual of Patent Examining Procedure, 8<sup>th</sup> Edition, Revision 4 (MPEP), § 2143.01. The Examiner is reminded that “[i]f the proposed modification or combination of the prior art would change the principle or operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” See MPEP, Section 2143.01. “If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” See MPEP, Section 2143.01. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).” See MPEP, Section 2141.02. [Emphasis in original].

Applicant submits that the Examiner’s proposed combination of Anandan and Herrod would render Anandan unsatisfactory for its intended purpose and would change the principle or operation of Anandan. As discussed above, the system in Anandan either provides the consumer with a personal device having an affixed tag in advance of the consumer entering the store (See Anandan, paragraph 0031) or attaches the tag to the consumer’s own personal wireless device. See Anandan, paragraphs 0044 and 0045. Thus, there would be no need to provide a plurality of personal devices at the retail establishment as discussed by Herrod because each user would already have a personal device upon entering the retail establishment. Any attempt to introduce

a plurality of personal devices at the retail establishment would change the principle of operation of Anandan, which is based on each user having their own personal device.

Furthermore, requiring a user in Anandan to provide identifying information to activate a personal device renders Anandan unsatisfactory for its intended purpose. The system in Anandan is able to identify the user by the tag that has been attached to the user's personal device. *See* Anandan, paragraphs 0045 and 0046. As such, the system in Anandan does not have any need to activate a personal device by providing identifying information as recited by Applicant because the tag attached to the user's personal device in Anandan is able identify the user. In addition, Anandan seeks to identify the user upon entering and/or exiting the retail establishment (*See* Anandan, paragraph 0026), and therefore requiring a user to provide identifying information to activate a personal device (and possibly requiring the return of the personal device) as discussed in Herrod would severely limit the ability of Anandan to automatically complete those operations.

Therefore, since the Examiner has improperly combined Anandan and Herrod, Applicant submits that Anandan and Herrod cannot render unpatentable Applicant's independent claims 44 and 68.

Dependent claims 45-67 and 69-80 are believed to be allowable as depending from what are believed to be allowable independent claims 44 and 68, for all the reasons given above. In addition, claims 45-67 and 69-80 recite further limitations that distinguish over the applied art.

For the reasons provided below, it is further submitted that at least several of claims 45-67 and 69-80 recite further limitations that distinguish over the applied art.

Claims 48 and 73 recite that the user identification system includes the user interface of the portable display unit, and entering, by a user, a personal identification number and associated password into the portable display unit, respectively. Anandan, as understood by Applicant, does not teach or suggest these limitations and does not discuss any such functionality. The Examiner alleges that Anandan teaches or suggests this limitation at the abstract and paragraphs 0003, 0007, 0009, 0011, 0012, 0013, 0026, 0027, 0028, 0035, 0037, 0041, 0043, 0044, 0062, 0065 and 0069. However, Applicant cannot identify any description or discussion in the Examiner's cited passages that relates to the limitation and requests that the Examiner specifically identify the passage in Anandan that the Examiner believes teaches the limitation.

Furthermore, there is nothing in Herrod that teaches or suggests the limitations not taught or suggested by Anandan.

Claims 49 and 76 recite that the personalized information includes a personalized shopping list, and transmitting a personalized shopping list, respectively. Anandan, as understood by Applicant, does not teach or suggest these limitations and does not discuss any such functionality. The Examiner alleges that Anandan teaches or suggests this limitation at the abstract and paragraphs 0003, 0007, 0009, 0011, 0012, 0013, 0026, 0027, 0028, 0035, 0037, 0041, 0043, 0044, 0062, 0065 and 0069. However, Applicant cannot identify any description or discussion in the Examiner's cited passages that relates to the limitation and requests that the Examiner specifically identify the passage in Anandan that the Examiner believes teaches the limitation. Furthermore, there is nothing in Herrod that teaches or suggests the limitations not taught or suggested by Anandan.

Claims 50 and 77 recite that the personalized information further includes information on products on the personalized shopping list that are located in proximity to the location of the portable display unit, and transmitting information on products on the personalized shopping list that are located in proximity to the location of the portable display unit, respectively. Anandan, as understood by Applicant, does not teach or suggest these limitations and does not discuss any such functionality. The Examiner alleges that Anandan teaches or suggests this limitation at paragraphs 0032 and 0033. However, Applicant cannot identify any description or discussion in the Examiner's cited passages that relates to the limitation and requests that the Examiner specifically identify the passage in Anandan that the Examiner believes teaches the limitation. Furthermore, there is nothing in Herrod that teaches or suggests the limitations not taught or suggested by Anandan.

Claims 56 and 70 recite calculating the location of the portable display unit in a commercial establishment by at least one of biangulation techniques or triangulation techniques. Anandan, as understood by Applicant, does not teach or suggest these limitations and does not discuss any such functionality. The Examiner alleges that Anandan teaches or suggests this limitation at the abstract and paragraphs 0003, 0007, 0009, 0011, 0012, 0013, 0026, 0027, 0028, 0035, 0037, 0041, 0043, 0044, 0062, 0065 and 0069. However, Applicant cannot identify any description or discussion in the Examiner's cited passages that relates to the limitation and

requests that the Examiner specifically identify the passage in Anandan that the Examiner believes teaches the limitation. Furthermore, there is nothing in Herrod that teaches or suggests the limitations not taught or suggested by Anandan.

In conclusion, it is respectfully submitted that claims 44-80 are not anticipated nor rendered obvious by Anandan and/or Engelke and are therefore allowable.

**Newly Added Claims**

Claims 81 and 82 are newly added by the Response to further define Applicant's invention. It is submitted that no new matter has been added by new claims 81 and 82 because support for the claims can be found in the specification and in claims 44-80. Claims 81 and 82 are believed to be allowable for the reasons set forth greater detail above with respect to independent claims 44 and 68. In addition, claims 81 and 82 recite further limitations that distinguish from Anandan and Herrod.

**CONCLUSION**

In view of the above, Applicant respectfully requests reconsideration of the Application and withdrawal of the outstanding rejections. As a result of the amendments and remarks presented herein, Applicant respectfully submits that claims 44-82 are not anticipated by nor rendered obvious by Anandan, Herrod or their combination and thus, are in condition for allowance. As the claims are not anticipated by nor rendered obvious in view of the applied art, Applicant requests allowance of claims 44-82 in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicant.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,  
**McNEES, WALLACE & NURICK**

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By

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Dated: August 17, 2006